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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/620,823

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7590

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EXAMINER

PATEL, DHIRUBHAI R

ART UNIT

PAPER NUMBER

2831

DATE MAILED: 09/09/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/620,823

Applicant(s)

SHIMOLA ET AL.

Examiner

DHIRU R PATEL

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 8/10/04.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-28 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 7-22 is/are allowed.
- 6) ☒ Claim(s) 1-6, 23-28 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

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1. The finality of final rejection mailed on 6/22/04 is hereby vacated in view of the newly discovered reference(s) to M. J. Sturtevant et al (3,244, 802). Rejections based on the newly cited reference(s) follow. Any inconvenience to the Applicant is regretted.

Claim Rejections - 35 USC § 112

2. Claims 1-6, 23-28 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for a grommet, the specification does not reasonably provide enablement for said inner and outer surfaces being arcuate in the direction from said other end toward said one end and converging in said direction (for claims 1-6), and method of sealing to the substrate (for claims 23-28, lines 1-7) . The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make or assemble the invention commensurate in scope with the claims. The specification doesn't reasonably disclose the claimed subject matter of claims 1 and 23, and therefore the subject matter of claims 1 and 23 is not enabled by the disclosure of the invention. The applicant is required to cancel the claim or provide a reasonable explanation of why they feel the specification supports the subject matter as disclosed in claims 1 and 23 . Applicant must refer to the specification by page and line number, and to the drawing, if any, by reference characters.

Please note that the claim or claims (1-6, 23-28) must conform to the invention as set forth in the remainder of the specification and the terms and phrases used in the claims must find clear support or antecedent basis in the description so that the

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meaning of the terms in the claims may be ascertainable by reference to the description, see MPEP 608.01 (d)(1).

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3 Claim 1 as best understood, is rejected under 35 U.S.C. § 102(b) as being anticipated by M. J. Sturtevant et al (3,244, 802).

M. J. Sturtevant et al disclose:

Regarding claim 1, a grommet 18 (see fig 2, column 1 lines 50-55) for sealing a conductor 14 relative to a substrate 12 having opposite sides 38, 40 (see fig 2) and an opening 24 therethrough for a conductor 14 (see fig 2 and the entire column 1), said grommet being tubular and of a resilient material (see column 2 lines 30-35, entire column 3) and having axially opposite ends (see fig 2), one of said ends (near element 24) for sealingly engaging with a conductor 14 (see fig 2) and the other of said ends (between elements 22 and 32) having an inner surface radially spaced from the conductor and an outer surface diametrically larger than the opening through the substrate 12 (see fig 2), said inner and outer surfaces being arcuate in the direction from said other end toward said one end and converging in said direction (see fig 2).

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Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103 (a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(f) or (g) prior art under 35 U.S.C. 103(a).

4. Claim 23 as best understood, is rejected under 35 U.S.C. § 103 (a) as being unpatentable over M. J. Sturtevant et al (3,244, 802) in view of Moore et al (6,064,003).

Assembly of the device of M. J. Sturtevant et al comprises the method step of :

Regarding claim 23, a method of sealing a conductor 14 (see fig 2 and the entire specification) a substrate 12 having opposite sides 38, 40 (see fig 2) and an opening 34 (see fig 2) therethrough, comprising the steps of providing a resilient grommet 18 (see fig 2 and the entire specification) having a first end (near element 24) for sealingly engaging the

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conductor (see fig 2) and a second end (between elements 22 and 32) radially spaced from the conductor and larger than the opening (see fig 2), mounting the grommet on the conductor (see fig 2), inserting the conductor through the opening from one side of the substrate, and sealing the second end of the grommet to the substrate (see the entire specification), but fails to disclose a diametrically larger connector on an end thereof. Moore et al teach the use of a diametrically larger connector 60 on an end (see fig 1, column 3 lines 35-45) in order to receiving and retaining an end 62 of a flat flexible cable 20 (see column 3 lines 35-45), Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the assembly of M. J. Sturtevant et al with a diametrically larger connector on an end as taught by Moore et al in order to receiving and retaining an end of said cable 14. It is noted that the modified assembly of M. J. Sturtevant meet the structural limitation.

5. Claims 24-28 as best understood, are rejected under 35 U.S.C. § 103 (a) as being unpatentable over M. J. Sturtevant et al (3,244, 802) in view of Moore et al (6,064,003) as applied to claim 23 and further in view of Semrau (4,901,395).

Assembly of the device of M. J. Sturtevant et al comprises the method step of :

Regarding claim 24, the modified assembly of M. J. Sturtevant disclose all the features of the claimed invention as shown above, including said second end of said grommet includes a flange 30 (see fig 2, column 1 lines 60-65 of M. J. Sturtevant), but fails to disclose said sealing includes the step of adhesively bonding said flange to said one side of said substrate. Semrau teaches the use of a step of adhesively bonding (42') a flange 28' to

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one side 16' of a substrate 10' (see fig 3 and entire column 3) in order to provide tight fitting sealing relationship with both the surfaces 14 and 16 as well as juxtaposition with said side 16' (see column 3 lines 40-65). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the modified assembly of M. J. Sturtevant et al with said sealing includes the step of adhesively bonding said flange to said one side of said substrate as taught by Semrau in order to provide tight fitting sealing with relationship with both the surfaces as well as juxtaposition with said side .

Regarding claim 25, the modified assembly of M. J. Sturtevant disclose all the features of the claimed invention as shown above, including said adhesively bonding includes the steps of applying an adhesive to said one side of said substrate and pulling said grommet in the direction to engage said flange with said adhesive.

It is noted that the modified assembly of M. J. Sturtevant meet the structural limitations.

Regarding claim 26, the modified assembly of M. J. Sturtevant disclose all the features of the claimed invention as shown above, including said adhesively bonding includes the steps of applying adhesive to said flange and pulling said grommet in the direction for said adhesive to engage said one side of said substrate. It is noted that the modified assembly of M. J. Sturtevant meet the structural limitations.

Regarding claim 27, the modified assembly of M. J. Sturtevant disclose all the features of the claimed invention as shown above, including wherein said second end of said grommet includes a recess 28 (see fig 2 of M. J. Sturtevant) for receiving the peripheral edge of the opening and said sealing includes positioning said grommet for said recess to receive the

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edge of the opening. It is noted that the modified assembly of M. J. Sturtevant meet the structural limitations.

Regarding 28, the modified assembly of M. J. Sturtevant disclose all the features of the claimed invention as shown above, including wherein the step of positioning the grommet includes pulling said grommet outwardly relative to the other side of said plate. . It is noted that the modified assembly of M. J. Sturtevant meet the structural limitations.

Allowable Subject Matter

6. Claims 7-22 are allowed.

7. Claims 2-6 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

The following is a statement of reasons for the indication of allowable subject matter:

The primary reasons for the indication of the allowability of claims 2-22 are the inclusion therein, in combination as currently claimed, of the limitation of a radially extending peripheral flange having radially inner and outer peripheral surfaces respectively diametrically smaller and larger than the opening through the substrate (for claims 2-6), and a wall between said one and said other end having at least one re-entrant wall portion therein (for claims 7-22).

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The previously listed limitation is neither disclosed nor taught by the prior art of record, alone or in combination.

Conclusion

8. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Response to Arguments

9. Applicant's arguments with respect to claim 1, 23-28 have been considered but are moot in view of the new ground(s) of rejection.

Contact information

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10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dhiru Patel whose telephone number is 571-272-1983. The examiner can normally be reached on Mon-Fri.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dean Reichard can be reached on 571-272-2800 ext 31. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only.

For more information about the PAIR system, see <http://pairedirect.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll free).

Dhiru Patel
Primary Examiner
Group Art Unit 2831
September 5, 2004


DHIRU R. PATEL
PRIMARY EXAMINER
9/5/04